THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NICHOLAS A. AHR and GARY D. LAVON

Appeal No. 1998-2791
Application No. 08/422,676[1]

ON BRIEF

Before STONER, Chief Administrative Patent Judge and FRANKFORT and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 28, 29, 31 through 34 and 36. Claim 35, the only other claim pending in this application, stands

[1] Application for patent filed April 13, 1995. According to the appellants, the application is a continuation of Application No. 08/081,733, filed June 23, 1993, now abandoned.

withdrawn from further consideration under 37 CFR § 1.142(b)

as being directed to a non-elected species.

We REVERSE.

BACKGROUND

The appellants' invention relates to a disposable absorbent article comprising an inflatable component and first and second materials disposed on the article separated by a breakable barrier, wherein the first and second materials are combinable (by breaking of the barrier) to inflate the inflatable chamber. An understanding of the invention can be derived from a reading of exemplary claim 28, which appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Whyte	3,921,232	Nov. 25, 1975
Kato	4,781,645	Nov. 1, 1988
Lieberman	4,929,214	May 29, 1990

The following rejection is before us for review.

Claims 28, 29, 31-34 and 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Whyte in view of Lieberman and Kato.

Reference is made to the brief (Paper No. 22) and reply brief (Paper No. 25) and the non-final Office action mailed

March 25, 1996 (Paper No. 15), final rejection (Paper No. 18) and answer (Paper No. 23)[2] for the respective positions of the appellants and the examiner with regard to the merits of this rejection.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we shall not sustain the examiner's rejection.

Whyte discloses self-inflating structures comprising plural compartments which are "individually inflated at the point of use at the time of need as a dependent function of being used" (column 1, lines 21-24). More particularly, Whyte discloses absorbent structures, such as absorbent bed pads and

[2] In lieu of repeating the explanation of the rejection, the answer on page 3 states "[s]ee page 2, lines 1-4 of the FINAL rejection, Paper No. 18." The final rejection, however, similarly refers to "page 3, line 11 - page 6, line 12 of the last Office action, Paper No. 15." Such a procedure by the examiner is inappropriate. The Manual of Patent Examining Procedure (MPEP) § 1208 (6th ed., Revision 3, Jul. 1997), as written at the time the answer was mailed, expressly provided that incorporation by reference may be made only to a **single** other action. That provision remains unchanged in the current MPEP § 1208 (7th ed., Jul. 1998).

disposable diapers (40) which have low bulk prior to being inflated while enabling, when inflated, the resilient absorbent material (31) therein to absorb relatively large quantities of liquid compared to the amount of liquid such absorbent material could absorb if compressed under the weight of a bed patient or a sitting or lying infant (column 5, lines 23-32). The diaper disclosed by Whyte (Figures 8-10) comprises a laminated back sheet (200) including a substantially impervious lamina (222) and a semipermeable[3] lamina (223), an absorbent pad (31), a hydrophilic wicking sheet (228) and a hydrophobic top sheet (229). Upon wetting of the diaper from the upwardly facing side, the wicking sheet distributes moisture across a relatively large surface of the portions of lamina (223) defining self-inflatable pillows (21). Such moisture permeates lamina (223) and reacts with gas evolving material (24) comprising any of the materials enumerated in column 3, lines 41-46, disposed within the pillows (21) to cause release of carbon dioxide which then

[3] As used by Whyte, "semipermeable" describes material which is substantially pervious to the liquid (bodily fluids) sought to be absorbed by the absorbent material (31) and substantially impervious to gas evolved within the pillows, as discussed *infra* (column 5, lines 58-61).

inflates the pillows (21). Thus, the body weight of the user becomes supported by the inflated pillows (21) such that the absorbent material (31) expands, whereby its absorption capacity is increased.

We understand Whyte to disclose self-inflating absorbent articles having a plurality of inflatable chambers which are individually activated or inflated by absorption of bodily fluids when in use. Although the articles are capable of being activated or inflated by purposefully wetting the top faces thereof, such use of the articles is neither disclosed nor suggested by Whyte.

Kato and Lieberman both disclose inflatable devices, such as balloons, bags, dolls and the like (column 1, lines 7-10, of Lieberman and column 1, lines 35-44, of Kato) comprising gas (carbon dioxide) evolving material and an activator material (such as water) disposed in a gas-permeable enclosure within the inflatable device and separated from one another by a breakable barrier. Upon rupturing the breakable barrier by application of pressure from the hands of the user, the activator material and gas evolving material combine and react to evolve gas, whereby the device is inflated.

The examiner recognizes that Whyte differs from the invention recited in claim 28 in that it lacks at least "a breakable barrier" separating the gas evolving material (24) from the activator material (Paper No. 15, page 3), but asserts that

> [t]o employ a liquid impervious breakable packet containing the liquid, i.e. and thus necessarily a predetermined quantity or amount thereof, inside a gas permeable envelope both of which are inside a gas impermeable inflatable component as taught by Lieberman and Kato on the Whyte device would be obvious to one of ordinary skill in the art in view of the recognition that such a feature would provide a self inflating structure which is simplified in structure, economically efficient and/or reliably inflated while still providing the ability of individual inflation at the point of use at the time of need and the desirability of such in any self inflating device and/or the Whyte device [Paper No. 15, page 4].

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Indeed, a *prima facie* case of obviousness is established where the reference teachings would appear to be sufficient for one of ordinary

skill in the art having those teachings before him to make the proposed combination or modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Like the appellants, we note that Whyte discloses self-inflating absorbent articles that are inflated by wetting of the articles in use (i.e., absorbing excreted bodily fluids). The Whyte articles do not require any deliberate action by the person placing the articles under or on the bed patient or infant to inflate them but, rather, are designed to inflate automatically, in essence, upon wetting in use. Lieberman and Kato, on the other hand, disclose devices which are inflated only upon deliberate action by the user to rupture the breakable barrier, without regard to whether the devices are

externally wetted. While we appreciate that Lieberman and Kato are directed broadly to the problem addressed by Whyte (design of self-inflating articles using gas evolving material), given the disparate operation of the self-inflating mechanism of Whyte as compared with those of Lieberman and Kato, it is not apparent to us why one of ordinary skill in the art would have been led by the teachings of these references to replace the self-inflating arrangement of Whyte, requiring no deliberate inflating action by the user, with self-inflating arrangements as taught by Lieberman and Kato.

As to the examiner's stated motivation for making the proposed modification (Paper No. 15, page 4), the examiner has not provided any factual support for the conclusion that the proposed modification of Whyte would have yielded a more simplified, economically efficient or reliably inflated structure.

Accordingly, we shall not sustain the examiner's 35 U.S.C. § 103 rejection of claim 28, or claims 29, 31-34 and 36 which depend therefrom.

CONCLUSION

To summarize, the decision of the examiner to reject claims 28, 29, 31-34 and 36 under 35 U.S.C. § 103 is reversed.

REVERSED

BRUCE H. STONER, Jr. Administrative Patent Judge	)
CHARLES E. FRANKFORT Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)

JDB/pgg
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